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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,459	10/29/2003	Taro Suzuki	YTO-004	4579

20374 7590 11/28/2006

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EXAMINER

SCHLIENTZ, LEAH H

ART UNIT PAPER NUMBER

1618

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/695,459

Applicant(s)

SUZUKI ET AL.

Examiner

Leah Schlientz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-13 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of group IV, directed to a method of inhibiting allergens comprising the step of administering an aromatic hydroxyl compound, in the reply filed on 10/13/2006 is acknowledged, along with the election without traverse of an aromatic hydroxyl compound as the species to be searched. The election of a polyvinyl phenolic species, and more specifically poly-4-vinyl phenol, as the aromatic hydroxyl compound, in the supplemental response filed on 11/2/2006 is also acknowledged. Claims 11 – 13 and 35 – 37 are pending.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Suh *et al.* (US 6,117,440).

Suh teaches an alcohol-based aerosol spray composition which leaves on a sprayed surface a film which acts as a barrier to dust, dust mites, and their fecal excretions. The compositions include an alcohol soluble polymer, an acaricidal ingredient, and an antimicrobial ingredient (abstract). Mites and allergens associated with dust mites are controlled by applying

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the composition onto the surface of textile fabrics infested with said mites. The mites are killed and the production of additional allergens is thereby halted (column 5, lines 23 – 31). The antimicrobial component may be phenol (i.e. an aromatic hydroxyl compound) (column 8, lines 49 – 55).

Claims 11 – 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mckechnie *et al.* (US2004/0198625).

Mckechnie teaches cleaning compositions including a photocatalytic material and a sensitizer which combats soils or undesired microorganisms on a surface (abstract). Preferably, the composition also includes a film-forming polymer, which may include a polyvinyl phenol resin (paragraph 0046 or claims 1, 8, and 18). A residue or layer of the material is applied to a surface for cleaning or sanitizing of the surface. The compositions of the invention are used in combating allergenic soils associated with house dust mites (paragraphs 0014 – 0016). It is noted that the composition of Mckechnie includes components in addition to the film-forming polymer (i.e. titania and a sensitizer), but the comprising language of the instant claims does not exclude the presence of additional components. Regarding claim 13, the limitation wherein the aromatic hydroxyl compound is obtained by polymerizing or copolymerizing a monomer having the structure of formulas 1 – 6 appears to be a product-by-process type limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

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though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 11 – 13 and 35 – 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hidaka *et al.* (JP 59-100715).

Hidaka teaches synthetic fibers containing poly(p-vinylphenol). The fibers have lasting antimicrobial action (abstract). The bacteria to be treated are found in carpet, on the skin, in dust, etc. (page 67). As such, the antibacterial action of the fibers treated with poly(p-vinylphenol) compound would inhibit allergens on surfaces or surfaces where allergens are to be found, including clothing, carpets (abstract), because bacteria are within the scope of allergens, as bacteria are capable of eliciting an immune response in an individual. Regarding claims 13 and 37, the limitation wherein the aromatic hydroxyl compound is obtained by polymerizing or copolymerizing a monomer having the structure of formulas 1 – 6 appears to be a product-by-process type limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Conclusions***

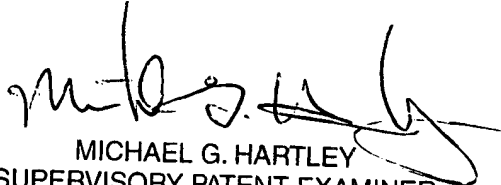
No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is 571-272-9928. The examiner can normally be reached on Monday - Friday 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lhs

  
MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER